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GROUP 3700

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 15

Application Number: 09/782,371

Filing Date: February 12, 2001

Appellant(s): CORNISH, LISA A.

Kurt M. Rylander
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed with a Certificate of Mailing dated 25 November 2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct. Additionally, Examiner acknowledges that Applicant proposed no amendments in the Response mailed on 24 April 2003. Examiner inadvertently checked the box on the Advisory Action stating that the proposed amendment would not be entered instead of the box stating that the request for reconsideration has been considered but does not place the application in condition for allowance.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct except that Issue 4 is no longer applicable as Examiner now withdraws the rejection of claims 8, 12, and 16.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-17 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8). However, Appellant's grouping of the claims is not agreed with as it pertains to Claims 11 and 15. Appellant has included Claim 11 in Group III, which contains claims having slit width range and slit spacing limitations. Because Appellant has written Claim 11 in the alternative to depend either from Claim 9 or 10, Claim 11 is properly grouped in Group III only when considered as depending from Claim 9, which has slit width range and slit spacing limitations. However, due to its alternative dependency on Claim 10, which has a zig-zag slit limitation, it must also be in Group V, which contains claims having slit width range limitations, slit spacing limitations, and a zig-zag slit limitation. Thus, should the rejection of the claims in either Group III or Group V be sustained, Claim 11 must stand rejected due to its alternative dependency on a claim having the rejected limitation. Similarly, Appellant has written Claim 15 in the alternative to depend either from Claim 13 or Claim 14 and included Claim 15 in Group V. Claim 15 is properly grouped in Group V only when considered as depending from Claim 14. However, when considered as depending from Claim 13, it contains only those limitations pertaining to Group III. Thus, Examiner proposes removing Claims 11 and 15 from Groups III and V, respectively, and considering them in a category of their own wherein they stand only if *both* Groups III and V stand but fall if *either* Group III or V falls.

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

US Pat. No. 3,304,945 ANDERSON 2-1967

US Pat. No. 3,103,933 SANZO 9-1963

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-17 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 6.

(11) *Response to Argument*

Examiner's complete position and Response to Arguments are contained in the prior Office Action, Paper No. 6. However, the following is offered to draw attention to several erroneous characterizations and assertions in Appellant's Brief.

Appellant makes much ado about the clamps in ANDERSON (see Appellant's Brief pages 4 and 5). Appellant attempts to argue that because ANDERSON has clamps, ANDERSON cannot disclose a slit width of 1/64 inch to 1/4 inch. Appellant cites a portion of ANDERSON that discloses that ANDERSON includes clamps that are "firmly clamped in position with a substantially fluid-tight seat whereby there is little or no

likelihood that the treating solution will seep downwardly through the clamp into contact with hair beneath the opening." (See Appellant's Brief, page 4, lines 13-16.) *Appellant* also asserts that "ANDERSON specifically teaches a zero or as close to zero width range when closed as possible" (see Appellant's Brief, page 5, lines 9 and 10); however, *ANDERSON does not* disclose this.

Appellant, in what appears to be a spurious argument, maintains that the clamp in ANDERSON precludes "such a wide gap," as if 1/64 inch is a gaping crevasse (see Appellant's Brief, page 5, line 3). However, it is pointed out, as it was already in the prior Office Action, Paper No. 6, that 1/64 inch is the width of just four average human hairs (an average human hair having a diameter of approximately .004 inch). It is further noted that ANDERSON discloses treating a *lock* of hair, i.e. a grouping of hairs (see ANDERSON col. 3, lines 23-28). The hairs are not treated one strand at a time. This lock of hair has an aggregate width equal to the sum of the individual hair diameters spanning it. Although relatively small, these hairs occupy a certain physical space that cannot be disregarded. Thus, ANDERSON does not preclude a slit width in the range of 1/64 inch to 1/4 inch, or much less, teach against such a range. Rather, ANDERSON *must have* a slit width that is at least 1/64 inch when closed in order to physically accommodate the lock of hairs. The "fluid-tight seal" is formed around the lock of hairs. Again, as already pointed out in the prior Office Action, Paper No. 6, even if ANDERSON is not considered as inherently disclosing the noted slit width, it still would

have been obvious for a person of ordinary skill in the art to modify it to have such a width, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

With regard to the spacing between the slits and the zig-zag shape, as already mentioned in the prior Office Action, Paper No. 6, these are also nothing more than obvious modifications. The case authority for this is cited in the prior Office Action. First, it is noted that Appellant knows that such modifications are routine and obvious to a person of ordinary skill in the art. The Appellant even admits in their specification on page 6, lines 9-15 that "those skilled in the art will know that the slits can be spaced apart in many different configurations. Those skilled in the art will know that the slits can be oriented in many different directions." It would be difficult to imagine a person of ordinary skill in the art who could form a cap as the one disclosed by ANDERSON but who would be confounded as to the manner of putting a bend in a clamp or moving the slits around into different positions. Next, Appellant asserts that an "optimum range for ANDERSON will not correspond to an optimum range for Appellant." (See Appellant's Brief, page 8, lines 19-21.) However, Appellant offers nothing in support of this proposition. In fact, the optimum range could be the same, and regardless, involves only routine skill to determine.

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For the above reasons, it is believed that the rejection of claims 1-7, 9-11, 13-15, and 17 should be sustained.

Respectfully submitted,

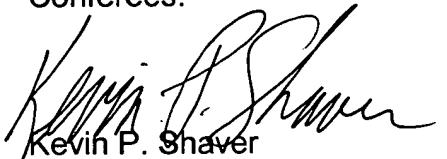


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March 10, 2004

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